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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/574,946	05/19/2000	Christine K. Shewmaker	CGNE.099.00USRe	9904

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EXAMINER

FOX, DAVID T

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 01/23/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/574,946

Applicant(s)

Shewmaker et al

Examiner

FOX

Group Art Unit

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--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 3/26/02 + 11/25/02
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-29, 32 and 34-138 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-29, 32 and 34-138 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 8
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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The amendments of 25 November 2002 have corrected the claim errors and continuity data errors set forth in the Office action of 27 September 2001, as well as the outstanding rejections under 35 USC 112, second paragraph, and 35 USC 102 and 103, except as indicated below. Claims 30 and 33 have been cancelled, and claims 131-138 have been newly submitted. Claims 1-29, 31-32, and 34-138 are pending and have been examined.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The Assignee's offer of 21 December 2000 to surrender the original patent, as reiterated on page 16 of the amendment of 25 November 2002, is acknowledged.

The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

The reissue oath/declaration filed 26 March 2002 is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Non-initialed and non-dated alterations have been made to the citizenship of inventor Facciotti.

Claims 1-29, 31-32 and 34-168 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

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The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Claims 19-29, 31-32, 34-44 and 62-138 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application, as stated on pages 3-7 in the Office action of 27 September 2001 for claims 19-44 and 62-130.

Claims 19-29, 62-130 and new claims 133-138 are drawn to DNA constructs comprising seed-preferred or seed-specific promoters, plants transformed therewith, and methods for selectively expressing genes of interest in seed tissue. Claims 19-29, 31-32, 34-44, and 62-138 are drawn to DNA constructs comprising light-regulatable or chloroplast-containing-tissue-preferred promoters, plants transformed therewith, and methods for selectively expressing genes of interest in chloroplast-containing tissue such as leaves. Claims 65-80 and 133-134 are drawn

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to DNA constructs comprising promoters which are preferentially expressed at a particular developmental stage of plant growth, which encompasses seed or embryo development or leaf development, and to methods for their use. However, claims drawn to this subject matter were cancelled during the prosecution of parent application Serial No. 08/105,852, in response to rejections applied against these claims under 35 USC 112, 102 and 103, as set forth in the Office action of 27 September 2001.

Applicants urge that no improper recapture exists, since Applicants filed continuing applications 08/484,941; 08/812,665; 09/232,861 and 09/782,130 to pursue the subject matter which was cancelled in application Serial No. 08/105,852, per the teachings of *In re Clement*, 45 USPQ 1161, 1163 (Fed. Cir. 1997) cited on page 17 of the response of 25 November 2002.

The Examiner directs Applicants' attention to the caveat recited in Footnote 2 on page 1169 of *Clement*:

“if an applicant amends a broad claim in an effort to distinguish a reference and obtain allowance, but *promptly* files a continuation application to continue to traverse the prior art rejections, circumstances would suggest that the applicant did not admit that the broader claims were not patentable--*assuming that the applicant does not ultimately abandon the continuation application because the examiner refuses to withdraw the rejections.*” [emphasis added]

In parent application Serial No. 08/105,852, Applicants cancelled all claims directed to seed-specific promoters, which had continued to be rejected under 35 USC 103, in their amendment of 2 January 1997. The application then passed to issue. It is this subject matter which Applicants now attempt to recapture in the instant reissue application.

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Continuing application Serial No. 08/484,941 was filed on 7 June 1995, prior to Applicants' cancellation of the subject matter now in dispute. The '941 application originally contained claims 1-4, 11-14, 22-25, 27-30 and 37-41 broadly drawn to any seed-specific promoter from any gene and from any plant. Claims 1-6, 15-32 and 41 of that application originally contained claims broadly drawn to any light-inducible promoter from any gene. In the first non-final Office action mailed 13 December 1995, the Examiner rejected these claims under 35 USC 112, first paragraph as well as 35 USC 103. In the second non-final Office action mailed 28 August 1996, the Examiner continued to reject under 35 USC 103 claims drawn to any seed-specific promoter from any plant (see, e.g., pages 4-8 of that Office action), and deemed the claims drawn to light-inducible promoters free of the prior art and enabled (see, e.g., page 8 of that Office action). In response, Applicants filed an amendment on 9 December 1996 which cancelled all claims drawn to seed-specific promoters. Only claims directed to light-inducible promoters remained in the application, and passed to issue as claims 1-8 of U.S. Patent 5,750,385. Thus, Applicants abandoned the broad claims in this continuing application, for which claims Applicants now seek prosecution in the instant reissue application.

Continuing application Serial No. 08/812,665 was filed on 7 March 1997, and originally contained claims 17-41 broadly directed to any seed-specific promoters, as well as claims 1-16 narrowly drawn to those particular seed-specific promoters that had been allowed in parent application Serial No. 5,420,034. In the first Office action mailed 22 January 1998, the Examiner rejected broad claims 17-41 under 35 USC 103 on pages 4-9, and indicated that narrow claims 1-

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16 were free of the prior art. Claims 17-41 remained rejected under 35 USC 103 in the final Office action mailed 10 August 1998. In the after final amendment of 7 January 1999, Applicants cancelled broad claims 17-41, and the application passed to issue. Thus, Applicants abandoned the broad claims in this continuing application, for which claims Applicants now seek prosecution in the instant reissue application.

Continuing application Serial No. 09/232,861 was filed 15 January 1999, two years after Applicants first cancelled the broad subject matter in parent application Serial No. 08/105,852. The '861 application originally contained claims 17-41 and 43-48 broadly drawn to any seed-specific promoter, and also contained claim 42 narrowly drawn to the exemplified and previously allowed seed-specific promoters. In the first Office action of 1 February 2000, the Examiner subjected claims 17-41 and 43-48 to enablement and written description rejections under 35 USC 112, first paragraph (see, e.g., pages 5-9 of that action), and subjected claims 17-41 and 43-48 to art rejections under 35 USC 103 (see, e.g., pages 10-15 of that action). In the final Office action of 4 October 2000, the Examiner maintained the rejections under 35 USC 112 and 103 as applied against the broad claims, but indicated that claims narrowly drawn to seed-specific promoters from *Brassica*, the source plant for all of the three seed-specific promoters exemplified by Applicants, would be enabled and free of the prior art. In the after-final amendment of 8 January 2001, Applicants amended the claims to be limited to seed-specific promoters from *Brassica*. No claims remained which were broadly drawn to any seed-specific promoter from any plant source. The application then passed to issue. Thus, Applicants abandoned the broad claims in this

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continuing application, for which claims Applicants now seek prosecution in the instant reissue application.

Continuing application Serial No. 09/782,130 was filed 12 February 2001, four years after Applicants first cancelled the broad subject matter in parent application Serial No. 08/105,852. This continuation application went abandoned during pre-examination processing on 12 July 2001. A petition to revive the abandoned application was entered 22 October 2002. Thus, Applicants did not *promptly* file this continuation application or *promptly* attempt to revive it.

Thus, the fact pattern in *Clement* does not apply. Applicants continued to abandon the disputed broadly claimed subject matter in continuing applications, and did not promptly file additional applications to pursue this subject matter. The instant reissue application appears to be the only application in which the broadly claimed subject matter is being pursued. Accordingly, claims 19-29, 31-32, 34-44 and 62-138 are an improper attempt to recapture subject matter which was surrendered in the application for the patent upon which the present reissue is based.

The effective filing date for claims 19-29, 62-130, and 133-138, insofar as they are drawn to seed-specific promoters and their use, is 31 July 1986, the filing date of parent application Serial No. 06/891,529 which was the earliest parent to teach such a promoter. The effective filing date for claims 19-29, 31-32, 34-44 and 62-138, insofar as they are drawn to chloroplast-containing-tissue-specific promoters and their use, is 17 November 1985, the filing date of parent application Serial No. 06/692,605 which was the earliest parent to teach such a promoter. The effective filing date for claims 1-29, 45-130, and 133-138, insofar as they are drawn to fruit-

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specific promoters and their use, is 26 May 1987, the filing date of parent application Serial No. 07/054,369 which was the earliest parent to teach such a promoter.

Claims 19-29, 62-130 and 133-138 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 5,420,034. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to utilize the DNA constructs containing a seed-specific promoter and plant cells containing them as claimed in the patent to obtain the DNA constructs containing a seed-specific promoter and methods for their use to obtain transformed plant cells and plants containing them as claimed in the instant application, as stated on page 8 in the office action of 27 September 2001 for claims 19-29 and 62-130.

Claims 19-29, 31-32, 34-44 and 62-138 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 5,750,385. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to utilize the DNA constructs containing a chloroplast-containing-tissue-specific promoter and methods for their use to obtain plant cells containing them as claimed in the patent to obtain the DNA constructs containing a chloroplast-containing-tissue-specific promoter and methods for their use to obtain transformed plant cells and plants containing them as claimed in the instant application, as stated on pages 8-9 in the Office action of 27 September 2001 for claims 19-44 and 62-130.

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Claims 1-29, 45-130 and 133-138 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 4,943,674. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to utilize the DNA constructs containing a fruit-specific promoter and methods for their use to obtain transformed plant cells and plants containing them as claimed in the patent to obtain the DNA constructs containing a fruit-specific promoter and methods for their use to obtain transformed plant cells and plants containing them as claimed in the instant application, as stated on page 9 in the Office action of 27 September 2001 for claims 1-29 and 45-130.

Applicants' intent on page 18 of the amendment of 25 November 2002 to file Terminal Disclaimers is noted. The double patenting rejections will be maintained until receipt of properly executed Terminal Disclaimers.

Claims 101-108, 129-130, 134 and 138 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 108, penultimate line, remains indefinite in its recitation of "said... translational initiation region specifically regulated" which lacks antecedent basis in the claims, as stated on page 10 of the Office action of 27 September 2001 for claims 76, 108 and 124. Only the transcriptional initiation region, and not the translational initiation region, is characterized as

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tissue-specific earlier in the claims. It is noted that Applicants have amended claims 76 and 124 to overcome this rejection; however, claim 108 was not so amended.

Claims 101, 105 and 108, and dependent claims 102-104 and 106-107, remain indefinite in their recitation of "which is from a gene native to a plant host or a mutant of a gene which is native to a plant host" as it is unclear to which of the preceding claim elements this phrase refers-- the DNA sequence of interest, the gene from which the promoter was derived, or something else, as stated on page 10 of the Office action of 27 September 2001.

Applicants urge in the amendment of 25 November 2002 that the claims are clear as written (see, e.g., page 22 of that response). The Examiner maintains that the claims could be interpreted in alternative ways, as set forth in the Office action of 27 September 2001.

Claims 129-130 (amended) and new claim 138 (newly submitted) are indefinite in their recitation of "a DNA sequence of interest other than the native coding sequence of said gene that is not a phaseolin coding sequence" which is unduly narrative and grammatically awkward. It is unclear whether the DNA sequence of interest is not supposed to be from the phaseolin gene; or whether the DNA sequence of interest *is* supposed to be from the phaseolin gene, since the coding sequence of a gene "other than" a particular coding sequence, wherein that particular coding sequence is of a gene "that is not a phaseolin coding sequence", would be the phaseolin coding sequence. If Applicants intend the coding sequence of the DNA construct not to be the phaseolin coding sequence, then the phrase should be rewritten as --a DNA sequence of interest other than the native phaseolin coding sequence--. If Applicants intended the promoter of the

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DNA construct to be from a gene other than the phaseolin gene, then the phrase --wherein said gene is not the phaseolin gene, -- should be inserted after “plant tissue of interest” in line 6, and the phrase “that is not a phaseolin coding sequence” in line 7 should be deleted.

Claim 134 (newly submitted) is indefinite because its preamble, a method for obtaining a plant with a regulatable phenotype, does not correspond to the final method step in the body of the claim, namely growing a plant for expression of the DNA sequence. See claims 129 and 137 for preferred language.

Claims 19-29, 62-130 and new claims 133-138 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for claims limited to the use of *Brassica*-derived seed-specific promoters for seed-specific gene expression, transcription, or phenotypic alteration; or for light-inducible/chloroplast-containing-tissue-specific or fruit-specific promoters and methods for their use; does not reasonably provide enablement for claims broadly drawn to the use of any promoter or any regulatory sequence from any plant source to effect seed-specific gene expression, transcription or phenotypic alteration; or any promoter which would effect any type of plant developmental stage-specific expression. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims, as stated on pages 11-13 in the last office action for claims 19-29 and 62-130.

Applicants urge on pages 18-20 of the amendment of 25 November 2002 that the scope of enablement rejection is improper, given Applicants' submission of references demonstrating the

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knowledge in the art of other seed-specific promoters and other tissue-specific types of promoters such as tuber-specific promoters, the failure of the Examiner to support his allegations, the guidance provided in the specification for the identification of other tissue-specific promoters, and the lack of a requirement that the specification teach what is well-known in the art.

The Examiner maintains that the specification itself must enable the claimed invention, rather than knowledge of those skilled in the art. See *Genentech, Inc. v. Novo Nordisk, A/S*, 42 USPQ2d 1001, 1005 (Fed. Cir. 1997), cited previously. The submission of a few scientific articles, most of which merely taught the isolation of genomic clones of seed-preferred genes, does not demonstrate that tissue-specific promoters were generally “well-known” in the art, particularly as of the effective filing date of 31 July 1986. In addition, none of the references published prior to 31 July 1986 provide any information regarding isolated seed- or tissue-specific promoters, the sequences responsible for said tissue specificity, or their ligation to heterologous coding sequences wherein tissue specificity is retained, as instantly claimed. Furthermore, Chandlee et al do not isolate or sequence any promoter or portion thereof, or even isolate any genomic clone. The patatin reference appears to have been published after the effective filing date of the instant application. See *In re Glass*, 181 USPQ 31, 34 (CCPA 1974), which teaches that references published after the filing date of an application may not be relied upon for the enablement of the specification.

Furthermore, the Examiner has supported his allegations with scientific reasoning and a scientific publication. Applicants’ suggestions in the specification to look for other types of

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tissue-specific promoters are mere invitations to experiment. In addition, the instant specification is a combination of three divergent applications which are each drawn to the isolation of particular types of organ-specific promoters, namely seed-, leaf- or fruit-specific promoters. These parent applications provided guidance for the isolation of their individual types of promoters, but did not provide any general guidance as to the identification or isolation of tissue-specific promoters in general, or their use to drive expression of heterologous coding sequences.

Claims 19-29, 62-130 and new claims 133-138 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, as stated on pages 13-14 of the Office action of 27 September 2001 for claims 19-29 and 62-130.

Applicants urge on pages 20-21 of the amendment of 25 November 2002 that the written description rejection is improper, given Applicants' disclosure, the analysis of regulatory regions by Chen et al published in November 1986, and the fulfillment of the written description requirements set forth in *Vas-Cath v. Mahurkar* (Fed. Cir. 1991).

The Examiner maintains that the instant disclosure does not identify particular sequences or structural features which are common to all tissue-specific promoters, and Chen et al do not cure this deficiency. Chen et al state that putative enhancer elements did not actually cause enhanced gene expression (see, e.g., paragraph bridging pages 8563 and 8564), so that actual correlations of structure and function were not elucidated. The authors also teach that plant

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promoters are not consistent in the types of sequences that are required for expression (see, e.g., page 8563, paragraph bridging the columns). Thus, the written description requirements for genes and gene sequences as set forth in the Written Description Guidelines issued in the Federal Register, Vol. 66, No. 4, 5 January 2001, "Notices", pages 1099-1111, have not been met. See also *University of California* cited previously, which was decided in 1997 and so supercedes *Vas-Cath*. It is noted that *Vas-Cath* did not deal with gene sequences.

Claims 129-130 and new claim 138 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are drawn to methods of plant cell transformation with DNA constructs which do not comprise portions of the phaseolin coding sequence. However, there is no basis for this limitation in the specification or the claims of parent application Serial No. 08/105,852, upon which this reissue application is based. Accordingly, these claims are drawn to NEW MATTER.

Applicants urge on page 21 of the amendment of 25 November 2002 that the recitation in the specification of the phaseolin promoter supports a negative limitation excluding it, per *In re Johnson*. The Examiner now agrees that claims drawn to the exclusion of the phaseolin promoter would not be considered new matter. However, the claims are not so limited, as discussed in the above rejection under 35 USC 112, second paragraph. Instead, the amended claims appear to be drawn to the exclusion of the phaseolin coding sequence.

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Claim 35 remains rejected under 35 U.S.C. 102(e) as being anticipated by Rogers et al (U.S. Patent 5,034,322 filed 5 April 1989, effective filing date 17 January 1983), as stated on pages 16-17 in the Office action of 27 September 2001 for claims 30, 32-35 and 37-39.

Rogers et al teach plant cells comprising DNA constructs comprising opine synthase promoters or the soybean SSU promoter for the expression of a heterologous kanamycin (phytotoxic antibiotic) resistance gene or a heterologous *aroA* gene encoding a mutant EPSPS conferring resistance to the herbicide glyphosate in transformed plant cells (see, e.g., column 16, lines 47-68; column 17, lines 1-51; column 18, line 63-column 20, line 47). Rogers et al also teach the high levels of transcription resulting from said SSU promoter (see, e.g., column 16, lines 56-61). The ability of the soybean SSU promoter to be regulated (or induced) by light would have been an inherent property.

Applicants urge on pages 23-24 that the 102(e) rejection over the Rogers et al patent is improper, given the failure of the patent to actually reduce to practice the claimed combination of a light-inducible promoter and a mutated *aroA* gene. The Examiner maintains that the patent teaches all of the individual elements and suggests their combination, thus providing a constructive reduction to practice, as taught by *In re Sivaramakrishnan*, 213 USPQ 441 (CCPA 1982) at page 442, penultimate paragraph.

Claims 31-32 and 34-44 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Zambryski et al taken with Rogers et al (U.S. Patent 5,034,322), as stated on pages 18-19 of the Office action of 27 September 2001 for claims 30-44.

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Applicants urge on pages 24-25 of the amendment of 25 November 2002 that the 35 USC 103 rejection over Rogers et al is improper, given the deficiencies of the reference as discussed above, and the failure of the prior art to teach or suggest the use of an antisense RNA-encoding construct. The Examiner maintains that Rogers et al is not deficient, as discussed above. With regard to the antisense RNA limitation, the Examiner notes that not all of the claims are drawn to this limitation. Furthermore, Applicants have not actually reduced this limitation to practice in order to provide any unexpected results regarding the tissue-specific expression of antisense RNA. In addition, Applicants' evidence of unexpected results is limited to the use of *Brassica*-derived seed-specific promoters, while the claims are broadly drawn to any seed specific promoter or any type of tissue-specific promoter. See In re Lindner, 173 USPQ 356 (CCPA 1972) and In re Grasselli, 218 USPQ 769 (Fed. Cir. 1983) which teach that the evidence of nonobviousness should be commensurate with the scope of the claims. Finally, it appears that Applicants' inventive concept is the use of tissue-specific promoters, rather than particular coding sequences. See In re Kuhle, 188 USPQ 7, (CCPA 1975), which teaches that a feature which solves no stated problem and which presents no unexpected results would have been an obvious matter of choice.

Claims 19-27, 62-130 and new claims 133-138 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hall et al. (U.S. Patent 5,504,200) taken with Sengupta-Gopalan et al., as stated on pages 19-21 of the Office action of 27 September 2001 for claims 19-27 and 62-130.

Claims 28-29 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Hall et al. (U.S. Patent 5,504,200) taken with Sengupta-Gopalan et al. as applied to claims 19-27 and 62-

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130 above, and further in view of Zambryski et al. taken with Pedersen et al., as stated in the Office action of 27 September 2001 on pages 21-22.

Applicants urge on pages 26-27 of the amendment of 25 November 2002 that the above two rejections under 35 USC 103 are improper, given the lack of suggestion to combine Hall et al and Sengupta-Gopalan et al. The Examiner maintains that such a suggestion exists within the references and within the recognition of those of ordinary skill in the art, as stated on pages 20-21 of the Office action of 27 September 2001.

Claims 1-18 and 45-61 remain deemed free of the prior art for the reasons presented in allowed parent application 08/105,852 corresponding to U.S. Patent 5,753,475.

Claims 131-132 (newly submitted) are free of the prior art, given the failure of the prior art to teach or suggest a method for obtaining light-induced heterologous gene expression specifically in chloroplast-containing plant tissue, as stated in allowed related application Serial No. 08/484,941 which issued as U.S. Patent 5,750,385.

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (703) 306-3218. The fax phone number for this Group is (703) 872-9306. The after final fax phone number is (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

January 15, 2003

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 160 1638

A handwritten signature in black ink, appearing to read "David T. Fox", is written over the typed name and title.